Third, Fujitsu argues that the pending patent appeal and reexamination may alter the result of Fujitsu's counterclaims. Opp. at 9, 21-22. Regardless of how Fujitsu's counterclaims are ultimately resolved, the Federal Circuit has already denied the University's right to an interlocutory appeal under *Puerto Rico Aqueduct*. In doing so it has weakened protections for sovereign States in a manner that will go unremedied unless the Court grants this petition.

II. THE FEDERAL CIRCUIT'S ERROR ERODES ELEVENTH AMENDMENT PROTECTIONS

The Federal Circuit decision is a significant departure from prior law—it is the first case since *Puerto Rico Aqueduct* that dismissed an appeal from a motion challenging claims on sovereign immunity grounds. In arguing that the decision breaks no new ground (Opp. at 11, 27-28), Fujitsu relies on the two cases already discussed by the University in its original petition. Pet. at 9 n. 5. In these cases, a State sought to appeal an immunity challenge to a particular type of damages—but conceded that the cause of action was proper. *Burns-Vidlak v. Chandler*, 165 F.3d 1257, 1260-1261 (9th Cir. 1999); *Mercer v. Magnant*, 40 F.3d 893, 896-897 (7th Cir. 1994).

By contrast, no court—before the Federal Circuit here—has held that it lacked appellate jurisdiction over a sovereign immunity challenge to a cause of action under *Puerto Rico Aqueduct*. Instead, the law was previously well-settled. Neither the University (which took an appeal) nor Fujitsu (which did not attempt to defend the Federal Circuit decision on jurisdiction even in its response to the University's rehearing petition) nor the district court (which granted an automatic stay of the counterclaims pending appeal) ever doubted that the district court order was appealable. The Federal Circuit decision changes sovereign immunity law in a harmful and disruptive way.

Fujitsu's opposition attempts to defend the merits of the Federal Circuit decision for the first time. Opp. at 22-29.

This argument ignores the inconsistency between the Federal Circuit's decision and *Puerto Rico Aqueduct*. In *Puerto Rico Aqueduct*, the Court established that denials of sovereign immunity claims as a class meet the requirements for immediate appealability under *Cohen*, stating "[o]nce it is established that a State and its 'arms' are, in effect, immune from suit in federal court, it follows that the elements of the *Cohen* collateral order doctrine are satisfied." *Puerto Rico Aqueduct*, 506 U.S. at 144. The principal reason for allowing an immediate appeal is to ensure "that the States' dignitary interests can be fully vindicated." *Id.* at 146. The Federal Circuit's attempt to re-weigh the *Cohen* factors to defeat such an appeal is not consistent with *Puerto Rico Aqueduct* and subsequent case law. *See* Pet. at 7-9 (citing cases); *see also Johnson v. Jones*, 515 U.S. 304, 315 (1995) ("We of course decide appealability for categories of orders rather than individual orders").

Nor is the Federal Circuit's application of the *Cohen* factors correct. The district court decision on the merits satisfied the requirement that the matter be "conclusively determined," as *Sherwinski* demonstrates and as discussed above. The district court order resolved a question "separate from the merits of the action" (the second *Cohen* factor). Fujitsu has not explained why the merits of the affirmative defenses should be decided before the issue of immunity—or why an appeal under *Puerto Rico Aqueduct* should have to await such a decision. As to the third requirement that the matter be "unreviewable on appeal," forcing a State to litigate claims in federal court as to which it is immune is not a harm that can be remedied by a later appeal. Instead, it is precisely the harm that *Puerto Rico Aqueduct* attempted to prevent.

CONCLUSION

The University respectfully requests that this Court grant the petition for writ of certiorari or, alternatively, summarily reverse the Federal Circuit's dismissal of the appeal.

Respectfully submitted,

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